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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,684

09/05/2003

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06/27/2008

EXAMINER

KUGEL, TIMOTHY J

ART UNIT

PAPER NUMBER

1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/656,684	Applicant(s) MILLER ET AL.	
	Examiner Timothy J. Kugel	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5, 9-12, 16-20, 22, 25 and 29-35 is/are allowed.
- 6) ☒ Claim(s) 1, 6-8, 13-15, 21, 23, 24 and 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :01/28/2008, 03/07/2008 & 04/10/2008.

DETAILED ACTION

1. Claims 1-35 are pending as amended on 21 April 2008.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.

Response to Amendment and Argument

3. Applicant's amendment to the claims and specification filed 21 April 2008 has been entered and fully considered.
4. Applicant's amendment to the specification, particularly providing antecedent basis for the limitation of claim 29 has been fully considered and overcomes the previous objection to the specification under 37 CFR 1.75(d)(1), which has been withdrawn.
5. Applicant's amendment to claim 28, correcting minor informalities, has been fully considered and overcomes the previous objection, which has been withdrawn.
6. Applicant's amendment to claim 29, further limiting the subject matter of claim 30—from which claim 29 depends—has been fully considered and overcomes the previous objection under 37 CFR 1.75(c), which has been withdrawn.

7. Applicant's further amendment to claim 29, deleting the new matter identified in the previous Office action has been fully considered and overcomes the following:

The rejection of claim 28 under 35 USC 112, first paragraph, as failing to comply with the written description requirement has been withdrawn.

8. Applicant's amendment to claims 14, 16, 27 and 32, including steps related to drilling in a subterranean formation in claims 14-25 and 32 and steps related to making the drilling fluid in claim 27, has been fully considered and overcomes the following:

The rejection of claims 14-25, 27 and 32 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

9. Applicant's further amendment to independent claim 14, particularly requiring the emulsion base to be synthetic has been fully considered and overcomes the following:

The rejection of claims 14, 15, 21, 23 and 26 under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over US Patent 4,777,200 (Dymond hereinafter) has been withdrawn.

10. Applicant's arguments, filed 21 April 2008, have been fully considered but are not persuasive.

Applicant argues that US Patent 4,777,200 (Dymond hereinafter) does not teach synthetic based drilling fluids and that one of ordinary skill in the art would not have

been motivated to include the synthetic oil teachings of US Patent 6,006,831 (Schlemmer hereinafter) with those of Dymond in that Schlemmer is directed to well logging which is not known to those of ordinary skill in the art of well treatment and further that Schlemmer teachings are insufficient to show functional equivalence of mineral oil and synthetic paraffins and olefins; however, first, *KSR* forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness (See *Ex Parte Smith*, 83 USPQ2d 1509, Bd Pat App & Interf, June 25 2007 citing *KSR*, 82 USPQ2d at 1396) and second, ample rationale to combine the teachings is found in the teaching of Schlemmer that the mineral oil taught by Dymond is equivalent to the synthetic paraffins and olefins taught by Schlemmer. Regarding applicant's assertion that one of ordinary skill in the art of wellbore drilling would not have known of the logging process taught by Schlemmer, Schlemmer clearly teaches that logging may take place “**during** or after drilling” (Schlemmer Column 1 Lines 26, emphasis added) therefore one of ordinary skill would have had knowledge of such processes and would have assumed that such base fluids taught by Schlemmer could have been used during drilling.

Applicant further argues that the invention of the instant claims is distinguished from Dymond in that fewer components are required in the instantly claimed fluids; however, the instant claims only exclude the use of fluid loss control agents, filtration control agents and organophilic clays—and it is noted that independent claims 27, 28 and 32 make no such limitation—and Dymond makes no teaching that such are required and therefore meets those exclusions.

Applicant still further argues that Dymond makes no teaching of utility over “the broad temperature range” taught and claimed; however, first, independent claim 32 has no temperature range limitation and further, since Dymond and Schlemmer combine to teach the same compositions used in the same manner as claimed, one of ordinary skill in the art at the time the invention was made would have expected that said compositions would have intrinsically had the same utility over the same temperature ranges as instantly claimed.

Applicant finally argues that the test results disclosed by applicant in the instant specification distinguish over Dymond; however, the test results disclosed are of significantly narrower scope than the instant claims—in both components used and amounts of each component—and evidence of non-obviousness must be reasonably commensurate in scope with the claimed invention. See, e.g., *In re Kulling*, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 777 (Fed. Cir. 1983). *In re Soni*, 54 F.3d 746, 34 USPQ2d 1684 (Fed. Cir. 1995) does not change this analysis.

Information Disclosure Statement

11. The information disclosure statements submitted on 28 January 2008, 7 March 2008 and 10 April 2008 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statements.

It is noted that applicant has submitted 13 information disclosure statements citing 242 references covering 6205 pages of text.

Claim Rejections - 35 USC § 103

12. Claims 1, 6-8, 13, 24, 27 and 28 stand and claims 14, 15, 21, 23 and 26 are rejected under 35 USC § 103(a) as being unpatentable over US Patent 4,777,200 (Dymond hereinafter) in view of US Patent 6,006,831 (Schlemmer hereinafter).

Dymond teaches an invert emulsion (Abstract) drilling fluid (Column 1 Lines 8-14) within the scope of the present invention, which comprises copolymers having 25 to 100% of a polar hydrophobic monomer (Abstract and Column 6 Lines 40-63) such as the claimed 2-ethylhexyl acrylate (Column 7 Lines 19-23) and 0 to 20 % of a hydrophilic monomer (Column 7 Lines 19-23) such as acrylic acid (Column 7 Lines 56-64) and that the copolymer may be in the form of particles coated with a hydrophilic coating (Column 7 Lines 23-33). Since the fluids may be used as drilling fluids, the use of “consisting essentially of” cannot distinguish.

Dymond, while teaching mineral oil, does not disclose expressly the use of a synthetic oil.

Schlemmer discloses a wellbore treatment fluid comprising any of aliphatic or aromatic mineral oils or synthetic hydrocarbons such as paraffins or olefins (Schlemmer Column 8 Lines 55-67).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace the mineral oil taught by Dymond with the synthetic paraffins or olefins of Schlemmer. The rationale to do so would have been the motivation provided by the teaching of Schlemmer that the mineral oils of Dymond are functional equivalents

to the synthetic paraffins and olefins taught by Schlemmer (Schlemmer Column 8 Lines 55-67).

Since Dymond and Schlemmer combine to teach the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the progressive gel and stress build behavior, suspension, fluid loss control, filtration control, thickening, yield and sag behavior and viscosity of the Dymond/Schlemmer composition would intrinsically be the same as claimed. If there is any difference between the product of Dymond and Schlemmer and the product of the instant claims the difference would have been minor and obvious.

Allowable Subject Matter

13. Claims 2-5, 9-12, 16-20, 22, 25 and 29-35 are allowed for the reasons of record.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Timothy J. Kugel/
Patent Examiner, AU 1796